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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/148,749 09/04/98 SMITH

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IM22/0522

EXAMINER

IP, S

ART UNIT

PAPER NUMBER

1742

12

DATE MAILED:

05/22/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.

Applicant(s)

Examiner

Group/Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 3/9/01
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1, 4-7, 10-13, 16-19 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1, 4-7, 10-13, 16-19 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 4-7, 10-13, and 16-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5-8, 10-15, and 17-20 of copending Application No. 09/100,605.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the alloy compositions in instant claims are overlapped by the alloy compositions of copending application.

3. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1, 4-7, 10-13, and 16-19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as being unpatentable over USP 4764225 to Shankar et al (col. 3, lines 7-50 and col. 4, lines 8-24), USP 5780116 to Sileo et al (col. 7, line 45 to col. 8., line 30), or USP 3015558 to Grant (col. 2, lines 5-54).

7. Claims 1 and 4-6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as being unpatentable over USP 5900078 to Yakuwa et al (col. 2, lines 20-61 and col. 4, lines 11-66).

8. All above cited references are submitted by applicants in PTO-1449.

9. The cited references disclose the features substantially as claimed. The disclosed features include the claimed Ni-Cr-Co alloy. Therefore, the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the subject matter disclosed by the reference. Overlapping ranges have been held to be a prima facie case of obviousness, See MPEP § 2112.01, In re Best, 195 USPQ 430, In re Malagari, 182 USPQ 549, In re Titanium Metals Corporation of America v. Banner, 227 USPQ 773 (Fed. Cir. 1985), In re Woodruff, 16 USPQ 2d 1934, and In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976).

10. Grant teaches about 28-45 wt.% Cr which is about the same as claimed Cr contents (instant claims 4, 7, and 10 about 27 wt.% Cr; claim 19 about 26 wt.% Cr). In re Preda, 159 USPQ 342 and In re Ayers, 154 F 2d 182, 69 USPQ 109 (CCPA 1946). Moreover, it is well settled that a prima facie case of obviousness would exist where the claimed ranges and prior art do not overlap but are close enough that one skilled in the art would have expected them to have the same properties, In re Titanium Metals Corporation of America v. Banner, 227 USPQ 773 (Fed. Cir. 1985), In re Woodruff, 16 USPQ 2d 1934, and In re Aller, 105 USPQ 233.

11. With respect to the N content in claim 1, that the claimed N content reads on

zero, which suggests N could be eliminated from the claimed alloy.

12. With respect to the N content in claims 7 and 13, that the claimed N contents read on trace or impurity amount that would diffuse into the alloy during casting under N insert atmosphere or ambient atmosphere. Nonetheless, Grant in col. 2, lines 37-41 teaches N could be added as optional element to form nitrides (paragraph bridging col. 9-10). It has been held that combining known ingredient having known functions, to provide a composition having the additive effect of each of the known functions is within realm of performance of skilled artisan and is not a patentable subject matter. In re Castner, 186 USPQ 213 (217). The use of conventional materials to perform their known functions in a conventional process is obvious. In re Raner, 134 USPQ 343 (CCPA 1962).

Response to Arguments

13. Applicant's arguments filed March 9, 2001 have been fully considered but they are not persuasive.

14. Applicants argue that the claimed Cr content 28 wt.% in claim 1, about 27 wt.% in claim 4, 27 wt.% in claims 7 and 13, about 27 wt.% in claim 10, and about 26 wt.% in claim 19 are not overlapped and rendered obvious by about 28 wt.% Cr as disclosed by Grant. The examiner disagrees because Grant in col. 2, lines 5-8

teaches Cr content from about 28 wt.%, which anticipates 28 wt.% Cr as in claim 1 and overlaps with instant Cr contents about 27 wt.%, 27 wt.%, about 27 wt.%, 27 wt.%, and about 26 wt.% as in claims 4, 7, 10, 13, and 19 respectively. Moreover, it is well settled that a prima facie case of obviousness would exist where the claimed ranges and prior art do not overlap but are close enough that one skilled in the art would have expected them to have the same properties, *In re Titanium Metals Corporation of America v. Banner*, 227 USPQ 773 (Fed. Cir. 1985), *In re Woodruff*, 16 USPQ 2d 1934, and *In re Aller*, 105 USPQ 233. Furthermore, the page 3, first full paragraph of the instant specification discloses 28 wt.% Cr is acceptable.

15. Applicants' argument as set forth in paragraph bridging pages 6-7 of the instant remarks is noted. But, broad range is not indefinite. Furthermore, Mr. Smith in his declaration did not substantiate his opinion with any factual evidence that the claimed ranges are critical.

16. Assuming *arguendo* that applicants' statement "Ni-base alloy" merely means that the Ni content is greater than any other constituent (not required to be greater than 50 wt.%) is correct. But the statement is found inconsistent with applicant's assumption that the Ni content of Sileo reference includes zero.

17. Applicants' argument in the paragraph bridging pages 7-8 of the instant remarks is noted. But, the instant claims are not excluding powdered Ni alloy.

18. Applicants' argument in first full paragraph of page 8 is noted. But, about 4.5 wt.% Mo includes 4.0 wt.% Mo as taught. It is well settled that a prima facie case of obviousness would exist where the claimed ranges and prior art do not overlap but are close enough that one skilled in the art would have expected them to have the same properties, *In re Titanium Metals Corporation of America v. Banner*, 227 USPQ 773 (Fed. Cir. 1985), *In re Woodruff*, 16 USPQ 2d 1934, and *In re Aller*, 105 USPQ 233.

19. Applicants argue that the Cr and Mn contents of Shankar are broad and examples of Shankar are outside the claimed ranges. However, it is well settled that the examples of the cited reference are given by way of illustration and not by way of limitation. *In re Boe*, 148 USPQ 507 (CCPA 1966) and *In re Snow*, 176 USPQ 328. Furthermore, there is no evidence that the claimed ranges are critical.

20. Applicants argue that the claimed 21.5 wt.% Cr in instant claim 1 does not overlap with 21 wt.% as disclosed by Yakuwa. However, it is well settled that a prima facie case of obviousness would exist where the claimed ranges and prior art do not overlap but are close enough that one skilled in the art would have expected them to have the same properties, *In re Titanium Metals Corporation of America v. Banner*, 227 USPQ 773 (Fed. Cir. 1985), *In re Woodruff*, 16 USPQ 2d 1934, and *In re Aller*, 105 USPQ 233.

21. In response to applicants' remarks in paragraph bridging pages 9-10 of the instant remarks with respect to instant claims 7, 13, and their dependent claims that Yakuwa is not applied to said claims.

22. Applicants' argument as set forth in first full paragraph of page 10 of the instant remarks is noted. Applicants' attention is directed to Sileo col. 7, line 45 - col. 8, line 16 and Grant col. 2, lines 1-36, for examples, which disclose the claimed Ti and Y alloying elements.

Conclusion

23. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

The above rejection relies on the reference(s) for all the teachings expressed in the text(s) of the references and/or one of ordinary skill in the metallurgical art would have reasonably understood or implied from the text(s) of the reference(s). To emphasize certain aspect(s) of the prior art, only specific portion(s) of the text(s) have been pointed out. Each reference as a whole should be reviewed in responding to the rejection, since other sections of the same reference and/or various combination of the cited references may be relied on in future rejection(s) in view of amendment(s).

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All recited limitations in the instant claims have been met by the rejections as set forth above.

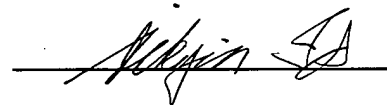
Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See MPEP § 2163.06 (a) and 37 C.F.R. § 1.119.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (703) 308-2542. The examiner can normally be reached on Monday to Friday from 5:30 A.M. to 2:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King, can be reached on (703)-308-1146.

The facsimile phone number for this Art Unit 1742 are (703) 305-3601 (Official Paper only) and (703) 305-7719 (Unofficial Paper only). When filing a FAX in Technology Center 1700, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.


SIKYIN IP
PRIMARY EXAMINER
ART UNIT 1742

S. Ip
May 21, 2001